

**REMARKS**

**I.      Status of the Application**

Claims 1-31 were originally filed in the present Application. By this Amendment, Claims 1, 3, 5, 7, 9, 12, 14, 15, and 22 have been amended, and Claims 2, 10, 11, 19, 20, and 21 have been cancelled. Thus, Claims 1, 3-9, 12-18, and 22-31 are pending.

Applicant's counsel thank Examiner Bui for taking the time to conduct interviews on October 14, 2004, and on November 16, 2004, with Applicant's attorneys. In view of those discussions, as well as the Amendments and Remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections and allowance of this application.

**II.     Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected Claims 1-31 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,046,564 to Poulsen ("Poulsen"), in view of U.S. Patent No. 2,891,624 to McBride ("McBride"). Applicant submits that the pending claims are patentable over the cited prior art.

**A.      Arguments Applicable to All Method Claims (1, 3-9, and 12-18)**

Pending Claims 1, 3-9, and 12-18 are all directed to methods for subduing a fire that include directing the exhaust of a turbine at, into, or in front of a front wall of a fire. Each of Claims 1, 3-9, and 12-18 contains some form of this element, and thus, arguments made with respect to this element are equally applicable to all of these claims. Specifically, neither Poulsen nor McBride discloses this element, and Poulsen and McBride cannot be properly combined because Poulsen teaches away from such combination.

Poulsen does not teach directing the exhaust at, into, or in front of a fire. To the contrary, Poulsen expressly teaches that the exhaust should be directed above the fire, and should not be aimed at the fire. (See Poulsen, Col. 2, Lines 30-34). Significantly, every independent claim of Poulsen includes the limitation "so that said gas stream is not aimed at the flames of said fire." (See Poulsen, Claims 1, 5, and 9). Poulsen's purpose of using a high-powered air stream is to

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launch material over the fire and great distances to get to the middle of a fire. (See Poulsen, Col. 2, Lines 20-30). In fact, Poulsen says that pointing exhaust at the fire will fan the flames, rather than subduing them. (See Poulsen, Col. 2, Lines 30-34). In the interview, the Examiner asserted that Poulsen inherently disclosed that the turbine exhaust would be directed, at least in part, into the fire. Applicant respectfully disagrees. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). The Examiner has provided no evidence showing that the gas stream of Poulsen would necessarily be directed into the front wall or edge of a fire or the landscape in front of the fire. Further, as described above, all the evidence currently of record indicates that the gas stream of Poulsen would not be directed into the fire. Therefore, Poulsen does not expressly or inherently disclose the step of directing the exhaust of a turbine into or in front of a fire.

McBride, at the very least, does not teach the use of a jet turbine to fight fires. Therefore, even assuming that McBride teaches directing an airstream into a fire, it cannot itself disclose the element of directing the exhaust of a turbine into or in front of a fire.

Additionally, McBride cannot properly be combined with Poulsen to form an obviousness rejection of the present claims because Poulsen teaches away from the proposed combination by having one aim the exhaust over the fire. A reference teaches away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Indeed, a disclosure that teaches away from, or discourages, the making of the claimed invention undermines a *prima facie* case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256 (C.C.P.A. 1963). Thus, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). As discussed above, Poulsen is designed for propelling a fire retardant long distances over the top of a fire, not directly at the fire’s front wall, and expressly teaches not to point the

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gas stream at the fire. In contrast, the present claims require the exact opposite – directing the exhaust at, into, or in front of a fire. Thus, Poulsen expressly says the present invention *will not* work, and a person of ordinary skill in the art would be discouraged from taking Applicant's path in improving on Poulsen. It is difficult to envision a clearer case of a reference teaching away than the present situation with Poulsen. Thus, in light of Poulsen's teaching away from Applicant's invention, the proposed combination of McBride and Poulsen is improper.

Further, Applicant respectfully reminds the Examiner that pending Claims 1, 3-9, and 12-18 are *method* claims, not apparatus claims. Thus, the Examiner's comparison between a select apparatus of Poulsen or McBride and the apparatus disclosed in Applicant's specification for practicing the methods of Claims 1, 3-9, and 12-18 is not proper. While an apparatus claim can be anticipated by a prior device that is similarly constructed and capable of performing the same function, it is not so with a method claim. *See Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 424 (1902). It is not enough that a prior device could be used to practice the claimed method. *See, e.g., Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303 (Fed. Cir. 2004) (method claim not invalidated by prior device later asserted to be usable in the claimed method). Instead, the prior device anticipates if it performs the claimed method in its normal and usual operation. *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986). The Examiner has pointed to no evidence indicating that the device of Poulsen or McBride performs the claimed methods in its normal and usual operation. In fact, as described above, the evidence currently of record indicates that the device of Poulsen is intended not to perform the claimed methods. Therefore, the Examiner's reliance on the apparatus of Poulsen or McBride to disclose the claimed methods is improper.

## 1.      **Claims 1 and 3-9**

Claim 1, as amended, contains the element, “directing the exhaust [of a turbine] at the flames of the fire, so that the exhaust is not aimed above the fire.” The arguments made above are fully applicable to this element of Claim 1. Specifically, neither Poulsen nor McBride discloses this element of Claim 1 expressly or inherently, and the proposed combination of Poulsen and McBride is not proper, because the references teach away from such combination.

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Therefore, the proposed combination of Poulsen and McBride cannot form a *prima facie* case of obviousness of Claim 1.

Claims 3-9 depend from Claim 1 and contain all the elements of Claim 1. Thus, for the reasons set forth above with respect to Claim 1, the Examiner has not formed a *prima facie* case of obviousness with respect to Claims 3-9.

## **2. Claims 12 and 13**

Claim 12, as amended, also contains the element “directing the exhaust into a moving front wall of the fire, generally against the movement of the front wall of the fire.” The arguments made above are fully applicable to this element of Claim 12. Specifically, neither Poulsen nor McBride discloses this element of Claim 12 expressly or inherently, and the proposed combination of Poulsen and McBride is not proper, because the references teach away from such combination. Therefore, the proposed combination of Poulsen and McBride cannot form a *prima facie* case of obviousness of Claim 12.

Claim 12 also contains the element, “supplying dust from a dust supply tank into the exhaust.” Neither Poulsen nor McBride teaches the introduction of dust into a turbine exhaust. Poulsen teaches use of water or “other fire retardant,” focusing completely on liquid fire retardants. (See, e.g., Poulsen, Col. 5, Lines 16-27). Poulsen does not mention any solid fire retardants, and thus does not suggest the application of a different solid fire retardant. Certainly Poulsen does not disclose the use of dust as a fire retardant. McBride does not disclose the use of any fire retardant. Therefore, neither Poulsen nor McBride discloses, teaches, or suggests the above element of Claim 12, and the Examiner has not made a *prima facie* case of obviousness with respect to Claim 12.

Claim 13 depends from Claim 12 and contains all the elements of Claim 12. Thus, for the reasons set forth above with respect to Claim 12, the Examiner has not formed a *prima facie* case of obviousness with respect to Claim 13.

## **3. Claims 14-18**

Claim 14, as amended, includes the element, “directing exhaust of a turbine into an area just in front of a front wall of the fire.” The arguments made above are fully applicable to this

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element of Claim 14. Specifically, neither Poulsen nor McBride discloses this element of Claim 14 expressly or inherently, and the proposed combination of Poulsen and McBride is not proper, because the references teach away from such combination. Therefore, the proposed combination of Poulsen and McBride cannot form a *prima facie* case of obviousness of Claim 14.

Additionally, neither Poulsen nor McBride discloses the use of the exhaust “to dislodge material from land near the fire causing the dislodged material to disperse into the fire.” In the interview, the Examiner indicated his position was that the methods of Poulsen and/or McBride would inherently dislodge material from land near the fire causing the material to disperse into the fire. Applicant respectfully disagrees. The Examiner has provided no evidence showing that the methods of use described in Poulsen or McBride would necessarily dislodge material and blow it into the fire. In particular, Poulsen instructs that the turbine should be aimed at an upward angle, which Applicant submits would be unlikely to dislodge material from the ground and blow it into the fire. Accordingly, the Examiner has not provided a sufficient showing of inherent disclosure to warrant a rejection of Claim 14.

Claims 15-18 depend from Claim 14 and contain all the elements of Claim 14. Thus, for the reasons set forth above with respect to Claim 14, the Examiner has not formed a *prima facie* case of obviousness with respect to Claims 15-18.

## B. Apparatus Claims (22-31)

Claim 22 is directed to the apparatus disclosed in the specification, rather than a method for subduing a fire. The Examiner rejected Claim 22 on the grounds that the “counterbalancing mechanism” as originally claimed could theoretically encompass a vehicle on which the turbine is mounted. Applicant has amended Claim 22 to clarify that the counterbalancing mechanism, as claimed, does not encompass the vehicle to which the mechanism is affixed. Claim 22, as amended, contains the element “an adjustable counterbalancing mechanism affixed to the vehicle to counteract the force of the exhaust.” The amendment clarifies that the counterbalancing mechanism must be adjustable in some way, which excludes the vehicle from its scope. Applicant notes that the term “adjustable” is not intended to require any particular means of adjustment, e.g., manual, hydraulic, mechanical, etc. Additionally, because Claim 22 requires that the counterbalancing mechanism is “affixed to the vehicle,” this element necessarily

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excludes the vehicle from its scope and clarifies that the vehicle and the counterbalancing mechanism are separate elements. In view of the above amendment and remarks, Applicant submits that the Examiner's rejection is fully addressed, and Claim 22 is in condition for allowance.

Original Claims 23-31 depend from Claim 22 and contain all the elements of Claim 22. Thus, for the reasons described above with respect to Claim 22, Claims 23-31 are patentable over the cited prior art and are in condition for allowance.

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### CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and allowance of the pending claims. Applicant also requests that the Examiner enter the Amendments contained herein. No new matter has been added. Applicant submits that the application is in condition for allowance and requests early notice of the same.

Respectfully submitted,

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By: \_\_\_\_\_

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#### CERTIFICATE UNDER (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 19, 2004.

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